

## **REMARKS**

Claims 1-40 were pending in the application. No claims have been amended, added or canceled. Accordingly, claims 1-40 remain pending in the application. Reconsideration is respectfully requested in view of the following remarks.

### **Section 102(e) Rejection:**

The Examiner rejected claims 1-15, 22-31 and 33-36 under 35 U.S.C. § 102(e) as being anticipated by Chirashnya (U.S. Publication 2002/0019870).

Claim 1 recites, in part, a host system configured to “update an availability of the network system using the data indicative of the configuration of the plurality of network components in response to identifying the failed component” and “store data indicative of the availability of the network system.” In rejecting claim 1, the Examiner asserts that Chirashnya teaches these limitations, and cites paragraphs 0034, 0047, 0048, 0051 and 0059 in support of this assertion. The Examiner is incorrect in this interpretation. Chirashnya does not teach, in the cited paragraphs or anywhere else, “updating an availability of a network system in response to identifying a failed component.” In fact, Chirashnya does not even teach updating the availability of a network system at all, much less updating it in response to identifying a failed component and using data indicative of the configuration of the plurality of network components, as recited in claim 1.

In response to Applicant’s previous arguments regarding claim 1 (on page 9 of the Final Action), the Examiner asserts that “in receiving an alarm indicating a fault in the network system, which sets forth which component failed, for example, the user of Chirashnya’s system is alerted of the network’s availability, by the very fact that the user knows which component failed, which constitutes a knowledge of the network system’s availability”. However, a user’s being “alerted” to or “knowing” “which component failed” is clearly not the same as a host system “updating an availability of the network system” using data indicative of the configuration of the plurality of network

components, as recited in claim 1. Mere identification of a particular failed component of a plurality of network components does not imply that the availability of the network system is thereby somehow updated. In fact, depending on the specific configuration of the network system, a failure of the same component may lead to completely different changes to the availability of the network system as a whole, so merely informing a user of the identity of a failed component cannot be the same as updating the availability of the network system.

Further with respect to claim 1, the Examiner asserts that Chirashnya teaches “storing data indicative of the availability of the network” in paragraph 0019. However, while paragraph 0019 teaches “gathering event reports”, “receiving a report of a change in configuration of the system”, “constructing a causal network”, “maintaining a database in which the configuration is recorded” and “updating the database responsive to the report of the change in the configuration”, it does not teach or suggest storing “data indicative of the availability of the network system”. Neither recording changes to a network configuration in a database, nor constructing a “causal network”, is the same as storing data indicating the availability of the network system.

For at least these reasons, Applicant respectfully submits that claim 1 is not anticipated by Chirashnya, and is in condition for allowance. Independent claims 7, 23, 34 and 35 each also recite computing (or calculating) an availability of a network system using configuration data obtained via system discovery, and therefore the rejection of these claims is unsupported by the cited art for similar reasons as claim 1.

Claim 2 recites, in part, using “the updated availability to calculate a risk of the network system becoming unavailable during one or more exposure periods following the failure and prior to a repair or replacement of the failed component, and storing data indicative of the risk”. The Examiner asserts that paragraphs 0024 and 0035 of Chirashnya teach this limitation. The Examiner is again mistaken. Neither of the cited paragraphs teach the limitation in question. In an apparent reference to claim 2, on page 10 of the Final Action the Examiner further asserts that “the calculation of a probability

of the system's failure in Chirashnya constitutes a risk of the network system becoming unavailable during the exposure period", without citing a specific portion of Chirashnya in support. Neither paragraph 0024 nor 0035, nor any other portion of Chirashnya, however, teaches or suggests "calculation of a probability of the system's failure". Even if Chirashnya did teach such a calculation, however, the Examiner would be incorrect in the assertion that such a calculation is the same as "using the updated availability to calculate a risk of the network system becoming unavailable during one or more exposure periods following the failure and prior to a repair or replacement of the failed component", as recited in claim 2. Furthermore, Chirashnya also does not teach storing an indication of the calculated risk corresponding to the one or more exposure periods. Accordingly, claim 2 is clearly not anticipated by Chirashnya. Claims 8 and 24 is also recites limitations using language similar to that of claim 2, and are therefore also not anticipated by Chirashnya for similar reasons.

Claim 3 recites the limitation "wherein the data indicative of the risk includes data indicative of a probability of the network system becoming unavailable during each of the one or more exposure periods". The Examiner asserts that Chirashnya teaches this limitation in paragraph 0010. Applicant again respectfully disagrees. There is no teaching or suggestion in paragraph 0010 or anywhere else in Chirashnya of using an updated availability of a network system to calculate and store probabilities of the network system becoming unavailable during one or more exposure periods between the failure and a repair/replacement. Accordingly, claim 3 is also not anticipated by Chirashnya. Claims 9 and 25 are also not anticipated by Chirashnya for similar reasons.

Claim 4 recites "wherein the data indicative of the risk includes data indicative of an expected number of system failures per a given population for each of the one or more exposure periods". In rejecting claim 4, the Examiner cites paragraph 0026 of Chirashnya as teaching this limitation. The Examiner is mistaken. While paragraph 0026 teaches "failure rate distributions", these failure rate distributions are for "malfunctions" of individual modules (see, e.g., paragraph 0023s, 0054), not "system failures" as recited in claim 4. Furthermore, paragraph 0026 does not teach failure rate

distributions associated with each of one or more respective “exposure periods”. In addition, Chirashnya teaches (e.g., in paragraph 0054) that “failure rates” are expressed as “mean time between failures (MTBF)”, which is different from the “number of failures per a given population” for a given exposure period. For at least these reasons, claim 4 is also not anticipated by Chirashnya. Claims 10 and 26 are also not anticipated by Chirashnya for similar reasons.

Claim 5 recites a host computer system configured to “compare the risk of the network system becoming unavailable for a first exposure period of the one or more exposure periods to a threshold value, and, if the risk is higher than the threshold value, determine an acceptable exposure period, wherein the risk of the network system becoming unavailable during the acceptable exposure period is lower than the threshold value, and provide an indication of the acceptable exposure period”. The Examiner asserts that paragraphs 0020, 0022, 0027, 0054 and 0063 of Chirashnya teach this combination of limitations. Applicant respectfully disagrees. None of the cited portions, or any other portion of Chirashnya, teach determining an acceptable exposure period with a lower risk of the network system becoming unavailable than a threshold risk value, and providing an indication of the acceptable exposure periods. Paragraph 0027 does teach “comparing one or more of the updated probabilities to a predetermined threshold, and invoking diagnostic action when the one of the probabilities exceeds the threshold. Typically, invoking the diagnostic action includes notifying a user of the system of the diagnosis, wherein notifying the user includes providing an explanation of the diagnosis based on the causal network.” However, the “updated probabilities” of paragraph 0027 refer to probabilities of malfunctions of individual components, not “risks of the network system becoming unavailable” during specific “exposure periods”. Furthermore, “providing an explanation of the diagnosis” is different from “providing an indication of an acceptable exposure period”. Paragraph 0063 teaches “Preferably, the user defines two threshold levels that are applied to each module: a lower threshold, at which a module is flagged as ‘fault-suspect,’ and a higher threshold, at which a suspect module is reclassified as non-suspect. The thresholds relate to the difference between the assessed malfunction rate of each module and its expected failure rate based on system

specifications.” However, the “two threshold levels” of paragraph 0063 also have nothing to do with determining an acceptable exposure period or providing an indication of such an acceptable exposure period, as recited in claim 5. Claim 5 is therefore clearly not anticipated by Chirashnya.

Claim 6 recites “wherein the host computer system is configured to update the availability of the network system by calculating the instantaneous availability of the plurality of network components”. The Examiner suggests that Chirashnya teaches this limitation in paragraphs 0011 and 0048. The Examiner is incorrect in this interpretation as well. Chirashnya does not teach a host updating the availability of the network system anywhere, and so cannot teach that the network system availability is updated by calculating the instantaneous availability of the plurality of network components, as recited in claim 6. Claim 6 is therefore clearly not anticipated by Chirashnya.

Claim 11 recites “wherein a first exposure period of the one or more exposure periods is an estimated time to replace the one of the components that failed”. The Examiner asserts that paragraph 0054 of Chirashnya teaches this limitation. However, Chirashnya does not mention “estimated times” to replace any components anywhere, much less setting an exposure period in a table to the estimated time to replace a failed component. Accordingly, claim 11 is clearly not anticipated by Chirashnya. Claim 31 is also not anticipated by Chirashnya for similar reasons.

#### **Section 103(a) Rejections:**

The Examiner rejected claims 16-19, 32, 37 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Chirashnya; claims 20 and 21 as being unpatentable over Chirashnya in view of Rogers (U.S. Publication 2003/0048782); and claim 39 as being unpatentable over Chirashnya in view of Noy (U.S. Publication 2003/0051049). Also, the Examiner takes “Official Notice” in rejecting claim 40 under 35 U.S.C. § 103(a) over Chirashnya.

With respect to claims 16-19, 32, 37 and 38 under 35 U.S.C. § 103(a), the Examiner repeats the assertion of the first Office Action that the features of claims 16-19 and 32 “constitute a design choice rather than a patentable distinction.” **The Examiner has once again not stated proper grounds for rejection.** All inventions constitute design choices made by the inventors. The statute clearly places a burden of proof on the Patent Office which requires the Examiner to produce a factual basis for his rejection of an application under sections 102 and 103. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). The Examiner’s statement that these claim feature are a matter of design choice is a conclusory statement with no factual basis. The Examiner has not provided any prior art reference establishing the obviousness of the recited claim limitations in combination with the other limitations of Applicant’s claimed invention. The Examiner has merely stated his own opinion, which by definition does not provide a factual basis for the rejection. As the Court of Appeals for the Federal Circuit recently explained in *In re Sang Su Lee*, Docket No. 00-1158 (Fed. Cir. January 18, 2002), “conclusory statements such as those provided by the Examiner that a claim limitation is only a design choice do not fulfill the Examiner's obligation.” “Deficiencies of the cited references cannot be remedied by the [Examiner’s] general conclusions about what is ‘basic knowledge’ or ‘common sense.’” *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). “Common knowledge and common sense ... do not substitute for authority.” *In re San Su Lee*. Common knowledge “does not in and of itself make it so” absent evidence of such knowledge. *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999). The Examiner’s rejection of claims 37 and 38 is also completely lacking any evidentiary support. Thus, the Examiner has failed to state a *prima facie* rejection of claims 16-19, 32, 37 and 38.

With respect to claims 20 and 21, in response to the previous Office Action, Applicants had indicated **two** requirements that had to be met for Rogers’ teachings to qualify as prior art. These two requirements were: first, that the Examiner must show that the subject matter on which the Examiner is relying on to reject Applicant’s claims is also present in Rogers’ provisional application or Rogers’ parent utility application, and second, that at least one claim of Rogers’ published application is supported (under 35

U.S.C. § 112) in a respective one of the priority applications that also includes the subject matter relied upon for the rejection. In the Final Action, the Examiner addresses the first requirement, stating “that the provisional application contains the exact same teachings as the published Rogers application used to reject claims 20 and 21”, **but does not address the second requirement.** In regard to the first requirement, Applicant notes that, contrary to the Examiner’s statement, the text of the provisional application does not appear to be identical to the text of the published application. **In regard to the second requirement, the Examiner has not even attempted to show that at least one claim of Rogers’ published application is supported (under 35 U.S.C. § 112) in a respective one of the priority applications that also includes the subject matter relied upon for the rejection.** Thus, the Examiner has still not met the burden required to qualify the use of Rogers as prior art, and the rejection of claims 20 and 21 remains **improper.** For each and every limitation of at least one claim of Roger’s published application, the Examiner must specifically identify in the priority document complete § 112 support. Otherwise, Rogers cannot be asserted as prior art.

The Examiner rejected claim 39 under 35 U.S.C. § 103(a) as being unpatentable over Chirashnya in view of Noy (U.S. Publication 2003/0051049). Applicants traverse this rejection for several reasons. First, the Examiner has not shown Noy to be a prior art reference. More specifically, Noy is a published U.S. patent application that was filed on Aug. 13, 2002, after Applicants’ filing date of Mar. 6, 2002. Noy does claim the benefit of a provisional application filed Aug. 15, 2001. However, the filing date of the provisional application can only be used as Noy’s prior art date for the subject matter that is common to both the published application and the provisional application. Since it is common practice for a later filed utility application to include more or different subject matter than its earlier provisional application, it is unclear whether the material in Noy relied upon by the Examiner was actually present in Noy’s provisional application. In fact, a quick review of Noy’s provisional application shows that it varies greatly from Noy’s published application. Therefore, Applicant asserts that the Examiner must show that the subject matter on which the Examiner is relying on to reject Applicant’s claims is

also present in Noy's provisional application. Until the Examiner has made this showing, the rejection is improper. *See, In re Wertheim*, 209 USPQ 554 (CCPA 1981).

Moreover, Noy's published application is not entitled to the filing date of the provisional application unless at least one claim of Noy's published application is supported (under 35 U.S.C. § 112) in the provisional application. Under 35 U.S.C. 119(e)(1) and/or 120, a published utility application is not entitled to its priority application's filing date as a prior art date unless at least one claim of the published utility application is supported (per 35 U.S.C. § 112) in the priority application. The rejection is improper unless the Examiner can show that Noy's published application has the necessary claim support in the provisional application. *See also* M.P.E.P. § 2136.03(IV).

The Examiner has the burden of proof to produce the factual basis for the rejection. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). **Since the Examiner has not proven that both of the above requirements have been met for Noy's teachings to qualify as prior art, the Examiner has not met this burden of proof and the rejection is improper.**

Still further with respect to claim 39, the Examiner asserts, while Chirashnya "does not specifically teach that system discovery entails sending a request for identification of the network component, and returning an identifier in response", Noy teaches "the unique identification of a network component by request (0008)". The Examiner is mistaken in this interpretation. Claim 39 recites "wherein said performing system discovery comprises sending a request for identification data to a particular network component of the plurality of network components; and the particular network component returning a unique identifier in response to the request for identification". Noy teaches "sending from a device component **within a model** of a computer network to each of its neighboring device components via outgoing links a path discovery request" (paragraph 0008), but this is very different from a host sending a request for identification data to a network component. Each "device component" of Noy **models** "one or more physical and/or logical aspects of a network element" (see, e.g., paragraph



0005) included within a “software and/or hardware agent” defined for the network element (paragraph 0005), and is not “a network component of a plurality of network components” forming a network system whose availability is updated using the configuration data obtained via system discovery, as recited in claim 39.

Still further, the Examiner’s suggested motivation for combining the teachings of Noy with those of Chirashnya is insufficient. The Examiner suggests that the motivation lies “in the fact that identification of the components would enable more efficient monitoring of the components, which would facilitate response in case of a failure”. However, the Examiner presents no evidence of a link between “identification” and alleged increased “efficiency of monitoring” of components. Applicants respectfully submit that “monitoring” a component without “identifying” the component does not make sense (exactly what would be monitored?), and that identification of components therefore cannot enable “more efficient monitoring” as suggested by the Examiner, and that the Examiner’s suggested reasoning for combining the teachings of Noy and Chirashnya is therefore flawed.

For at least the reasons cited above, the rejection of claim 39 is clearly unsupported by the art cited by the Examiner.

With respect to claim 40, the Examiner cites paragraph 0009 of Chirashnya as teaching “wherein said detecting the failure comprises monitoring performance of one of the components”, and takes Official Notice that “inclusion of a threshold value to determine component failure is well known in the art, wherever network performance is being monitored”. Pursuant to M.P.E.P. § 2144.03, Applicant traverses the Examiner’s taking of Official Notice. Applicant asserts that “determining that the one of the network components has failed if the performance falls below a threshold” as recited in claim 40 is not “well known in the art”. Pursuant to M.P.E.P. § 2144.03 Applicant asserts that “the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained”. *See also* 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). In addition, while paragraph 0009 of Chirashnya teaches that

“standard reliability theory techniques are based on sampling device performance under known conditions”, this is not the same as the detection of a failure of a component comprising “monitoring performance of the component”, as recited in claim 40. For at least these reasons, the rejection of claim 40 is clearly unsupported by the art cited by the Examiner.

Applicant also asserts that numerous other ones of the other dependent claims recite further distinctions over the cited art. However, since the rejection of the independent claims has been shown to be unsupported by the cited art, a further discussion of the dependent claims is not necessary at this time.

## CONCLUSION

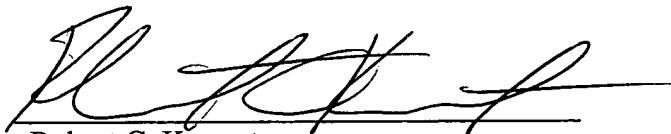
Applicant submits the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-10100/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Petition for Extension of Time
- ☐ Notice of Change of Address
- ☐ Other:

Respectfully submitted,



Robert C. Kowert  
Reg. No. 39,255  
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.  
P.O. Box 398  
Austin, TX 78767-0398  
Phone: (512) 853-8850

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